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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/869,397
Filing Date: June 28, 2001
Appellant(s): CHAPEL ET AL.

Jorge Tony Villabon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 07/27/2007 appealing from the Office action mailed 01/03/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,706,388	Isaka, Osamu	01-1998

6,115,799 Ogawa, Takeshi 09-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 5, and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Isaka (US Pat. No. 5, 706, 388).

Regarding claim 1, Isaka discloses a process for recording a digital video and audio data stream wherein recording being carried out on a medium organized in the form of logic blocks in series and comprising a recording and reading head (see fig. 2 components 5a, 6a and 7a and fig. 3, and col. 5 lines 59-64), said process comprises the steps of:

recording data on said medium as a pattern of at least one recorded block immediately followed by at least one unrecorded block (see col. 4 lines 54-58, col. 6 lines 6-24, and fig. 3): and following the triggering of the reading of the recorded data,

alternately reading a continuous series of said previously recorded blocks and continuing the recording of data in said unrecorded blocks immediately following the blocks read (see col. 5 lines 18-33 and 48-51 and abstract).

Regarding claim 2, Isaka discloses when the set of blocks recorded before the triggering of reading have been read, recording is continued in contiguous blocks in a non-interlaced manner (see abstract).

Regarding claim 5, Isaka discloses the recording of data is performed in a group of N contiguous blocks (N>1) (see fig. 1 and col. 6 lines 6-12).

Regarding claim 7, Isaka discloses a digital television receiver comprising means for receiving a digital audio and video data stream (see fig. 1), comprising:

a recording medium furnished with a recording and reading head, said medium being organized in the form of logic blocks in series (see figures 2 and 3);

a control circuit for managing the writing and the reading of blocks of the recording medium (see fig. 2);

an interfacing circuit for interfacing the recording medium with said control circuit, said control circuit adapted to control the recording of data on said medium as a pattern of at least one recorded block immediately followed by at least one unrecorded block, following the triggering of the reading of the recorded data, the alternate reading of a continuous series of said previously recorded blocks and the continuing of the recording of data in said unrecorded blocks immediately following the blocks read (see figs. 1-3 and rejection of claim 1).

Claim 8 is rejected for the same reason as discussed in claim 5 above.

Regarding claims 9 and 10, the limitation of claims 9 and 10 can be found in claim 1 above. Therefore claims 9 and 10 are rejected for the same reason as discussed in claim 1 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3-4 rejected under 35 U.S.C. 103(a) as being unpatentable over Isaka in view of Official Notice.

Regarding claims 3-4, claims 3 and 4 are differ from Isaka in that the claims further requires the set of blocks recorded before the triggering of reading have been read, recording is continued in contiguous blocks in a loop in the block previously read and blocks are read and rewritten in a non-interlaced manner. Although Isaka does not specifically disclose the set of blocks recorded before the triggering of reading have been read, recording is continued in contiguous blocks in a loop in the block previously read and blocks are read and rewritten in a non-interlaced manner, Isaka discloses the recording and reproducing operations are performed alternately. Isaka further discloses the recording/reproducing head moves after the recording in the n_{th} block completed (see col. 6 lines 13-24). Official Notice is taken that it would have been obvious to one

of ordinary skill in the art at the time the invention was made to modify Isaka by rewriting data on a block previously read and reproduce in order to use same blocks.

5. Claim 6 rejected under 35 U.S.C. 103(a) as being unpatentable over Isaka in view of Ogawa (US Pat. No. 6,115,799).

Regarding claim 6, claim 6 differ from Isaka in that the claim further require detecting sequences of free blocks on the medium for applying said steps of recording and reading. Although Isaka does not specifically disclose detecting sequences of free blocks, Isaka discloses the sequences of blocks in fig. 3 are free and predetermined data can be recorded on them (see col. 6 lines 6-12).

In the same field of endeavor Ogawa discloses successive free blocks are detected during search. Ogawa further discloses further discloses recording operation is performed by recording means (see claim 9). Therefore in light of the teaching in Ogawa it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Isaka by detecting a free area in order to record data of predetermined size on the searched area.

(10) Response to Argument

In re page 14 Appellant states "In contrast to the invention of the Appellant, at least as claimed by the Appellant's independent claim 1, Isaka teaches (see col. 4 lines 53-57) that "the data is recorded in consecutive areas on the recording medium 6a in the receiving order". Such teachings in Isaka are in direct contrast to at least the Appellant's claim 1 in which the data is recorded as a pattern of at least one recorded block immediately follwed by at least one unrecorded block. Therefore the data is not

recorded in the receiving order, as the blocks unrecorded are recorded later and are thus interlaced with data previously recorded."

In response the Examiner respectfully disagrees. As the Appellant states in the present invention data is recorded as a pattern of **at least one** recorded block immediately followed by **at least one unrecorded block** (emphasis added). Isaka discloses each of blocks 1 through n + 2 corresponds to an area of the recording medium 6a in which the predetermined amount of data corresponding to a capacity of the reception buffer memory is to be recorded. Isaka discloses operation is started from recording in the nth block. After the recording in the nth block is completed, to the block 1 to reproduce the data already recorded in block 1. Hence n + 1 is free or unrecorded block and n is recorded block. Therefore Isaka teaches at least one recorded block (n) is immediately followed by unrecorded block (n+1). Block n is immediately followed by block n + 1. See col. 6 lines 6-24 and fig. 3. The Appellant states that in the present invention the blocks unrecorded are recorded later (see the last statement in the above paragraph or page 14 paragraph 5 last statement). Isaka also teaches data will be recorded in block n+1. In addition, the claim does not specifically recites unrecorded blocks are interlaced with data previously recorded. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In re page 14 last paragraph the Appellant states "Nothing in Isaka indicates that the data is recorded in one block, then one block is left free, then another block is

recorded and so on, as thought in the Appellant's specification and claimed by atleast the Appellant's claim 1."

In response the Examiner respectfully disagrees. The claim does not specifically recites one block is left free then another block is recorded and so on. The claim recites only two blocks, **at least one** unrecorded block and **at least one** recorded block. Here the Appellant is stating three blocks where data is recorded in **one block (1)**, then **one block (2)** left free, then **another block (3)** is recorded. The claim does not specifically recites the above condition. Therefore the limitations of the claim read on the cited reference since the claim recites recorded block **immediately** followed by unrecorded block, i.e. the two blocks are adequate to meet the limitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the blocks being written one block over two or over three but not one block after the other without letting at least one free block between each recorded block (see page 15 last sentence of second paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Appellant states "... in our invention, the recording/reproducing head does not need to move from the recording position to the reproducing position as data is read and recorded in contiguous (successive) blocks which therefore does not require moving the head from one position to another contiguous position (see page 15 last paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to the Appellant's argument that the abstract of Isaka does not teach, suggest or anticipate at least how the blocks are recorded and read on the recording medium as thought in the Appellant's specification and as claimed in at least the Appellant's claim 1, the Examiner respectfully disagrees. Isaka discloses in the abstract controlling unit controls operations of the recording unit and the reproducing unit so that the reproducing operation on the video signal previously recorded on the recording medium and the recording operation on the video signal currently being received are performed at the same time, and thereby the video signal currently being received is recorded on the recording medium while an image is projected in accordance with the video signal previously recorded on the recording medium.

In response to applicant's argument that the arrangement is dedicated to the management of the buffer memories not to the arrangement of the main memory (see

page 16 paragraph 2), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to applicant's argument that the buffer memory of Isaka represents one embodiment to avoid having a delay induced by the movement of the head, the data being firstly stored in the buffer memory, so the buffer memory acts as a cache memory, and is not the same solution as the present invention (see page 17), the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In re page 17 Appellant states "..., in Isaka, there is only one block for recording and one block for reading and they are not blocks of the main memory 36 as thought and claimed by the Appellant, but are instead portions of the buffer 35."

In response the Examiner respectfully disagrees. Isaka teaches blocks 1 through n + 2 corresponds to an area of the recording medium 6a (see col. 6 lines 8-24). In addition the claim recites "a medium" which could be buffer, main memory, or a piece of paper as long as it records data, i.e. the claim does not specifically recites main memory or buffer.

In response to Appellant argument that the cited reference fails to teach, suggest or anticipate claim 5, the conferees respectfully disagrees. Isaka clearly teaches N contiguous blocks (see fig. 3 and col. 6 lines 6-24).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Therefore a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

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November 8, 2007

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